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Alan G. Towner
Pietragallo, Bosick & Gordon
One Oxford Centre, 38th Floor
301 Grant Street
Pittsburgh, PA 15219

EXAMINER

CHARLES, DEBRA F

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,458

Applicant(s)

BROWN, GORDON T.

Examiner

Debra F. Charles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Status of Claims

1. The Examiner is withdrawing this sentence in the previous Office Action "The statement of the status of the claims contained in the brief received 19 July 2002 is correct." And the Examiner acknowledges that the applicant added claims 28-70 in the communication received 19 July 2002.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 13 March 2003 as a copy of the IDS submitted 18 December 2001 was received and is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. The information disclosure statement (IDS) submitted on 19 June 2002 was received by this office before the first Office Action was mailed and was also in compliance with the provisions of 37 CFR 1.97. The Examiner encloses copies of both reviewed IDS forms.

Terminal Disclaimer

3. The terminal disclaimer filed on 15 May 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. PAT. 5,875,435 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

4. Applicant submits that Josephson et al. '190 alone, or in combination with Parker '368, does not teach or suggest the presently claimed invention as recited in independent Claims 28, 45, 51, 55, 59, 63, 67, 69 and 70.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Parker deals with IDs that can also be passwords as related to transactions and transaction codes. Josephson et al. and the applicant's invention also deal with transactions.

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The Attorney indicates that although the Office Action states that Josephson et al. `190 discloses a method of providing financial accounting statements, Applicant can find no such disclosure of an accounting statement in the reference.

Examiner indicates financial accounting statements is a broad term that applies to many financial reports created throughout an entity. Josephson et al. shows financial reports in Fig. 1(113A, 113B), Fig. 2(215), Fig. 3(215), Fig. 6(602, 603), Fig. 8(803), Fig. 9(803), Fig. 13(Control Report and Detail List of Pnote), Fig. 14(1413), Fig. 15(1505, 1507), Col. 14, lines 50-60, i.e. "summary record", "end of the day reporting".

The Attorney indicates the Office Action states that Josephson et al. `190 discloses a first entity and a plurality of other entities but does not specifically indicate what those entities are. For example, is the Examiner reading the presently claimed "first entity" as a payee bank disclosed by Josephson et al. `190, or as a "payor bank" disclosed by the reference?

The Examiner indicates Josephson et al. shows first entity and a plurality of other entities in col. 3, lines 55-67, i.e. "systems have dealt with the transfer of funds between a bank and an individual or corporation customer" and "Automated Clearing Houses". And the send and receive systems in cols. 14-21 are two separate entities.

The Attorney indicates the Office Action states that Josephson et al. `190 discloses the provision of transaction codes including standardized codes, but does not indicate what "code" of the reference the Examiner considers to represent a transaction code, or what "code" of the reference is considered to represent a standardized code. Clarification is respectfully requested.

The Examiner indicates Josephson et al. shows transaction codes and standardized codes in the Abstract, i.e. "provides presenting banks with the capability to automatically instruct the payor banks' systems as to the method of handling particular return checks, in advance of any return or pay/no pay decision by a payor bank, through the capability to append a selection disposition code to the electronic information associated with the check, at the time the check is initially processed". And in col. 17, lines 5-35, i.e. "a transaction code to denote disposition requirement".

The codes referenced here are standardized codes used and understood by both the presenting and payor bank.

The Attorney indicates similarly, the Office Action states that Josephson et al. `190 discloses separate financial transactions but does not specify what transactions disclosed in the reference allegedly read on Applicant's claimed separate financial transactions. Clarification is requested.

The Examiner indicates each presentment of a check by the presenting bank or entity to another bank (payor bank) or entity is a separate financial transaction. The entire patent 5,412,190 covers this topic.

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Furthermore, although the Office Action states that Josephson et al. `190 discloses the association of at least one of the transaction codes at about the time when funds are transferred or instructions are given for transfer to complete each financial transaction, Applicant cannot discern any such association step at about the time when funds are transferred or instructions are given for transfer in the Josephson et al. `190 reference. Clarification by the Examiner is requested.

The Examiner indicates that Josephson et al. does show associating transaction codes with funds transfer and associated instructions in the Abstract, i.e. "provides presenting banks with the capability to automatically instruct the payor banks' systems as to the method of handling particular return checks, in advance of any return or pay/no pay decision by a payor bank, through the capability to append a selection disposition code to the electronic information associated with the check, at the time the check is initially processed". And in col. 17, lines 5-35, i.e. "a transaction code to denote disposition requirement". Thus, the codes inherently incorporate instructions and enable the funds transfer.

The Office Action further states that Josephson et al. `190 discloses transmission of a record of each transaction in the at least one transaction code via a network to at least one file, but does not explain where Josephson et al. `190 discloses that a record of each transaction and at least one transaction code is transmitted via a network to at least one file. Again, clarification is requested.

The Examiner indicates that Josephson et al. shows a transmission record of each transaction in at least one transaction code via a network to at least one file in col. 14, lines 30-35, "electronic cash letter file", lines 54-60, i.e. "extract module formats and prints a paper detail report of all extracted items, and writes a summary record to an extract control file containing the extracted end point and summary totals of amounts and item counts at the bundle level of all cash letters extracted for electronic transmission" and col. 12, lines 20-27, i.e. "this electronic cash letter is then sent to the respective banks, using standard communication techniques over one or more electronic or optical data transmission networks".

The Office Action also states that Josephson et al. `190 discloses sorting the transactions in the at least one file and producing an accounting statement. Applicant can find no disclosure of such a transaction sorting step in at least one file in the Josephson et al. `190 reference, and can find no disclosure of the production of an accounting statement in the reference.

The Examiner indicates that Josephson et al. shows sorting transactions in at least one file and producing an accounting statement in col. 3, lines 15-27, i.e. "allows computer operator to obtain information on checks that have been reads such as total number of checks drawn on specific banks", and col. 4, lines 10-20, i.e. "disk files containing data that is captured during document processing operations . . . data communication, information sorting and comparison".

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Josephson et al. deals with a transaction system that creates reports. These reports can have any name, but they are all financial accounting reports that illustrate transaction activity in an entity.

Since the rejection based upon Josephson et al. '190 is maintained by the Patent Office, a detailed explanation by the Examiner of every feature disclosed by Josephson et al. '190 that allegedly reads on every feature of the presently claimed invention is respectfully requested has been provided herein.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 28, 29,30,31,32,33,35,37,41,42,43,44, 45,47, 51,52,53,54, 55,56,57,58, 59,60,61,62, 67,68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Josephson et al. (US 5412190A).

Re claims 28, 45, 51, 55, 59, 67 and 69, Josephson et al. disclose a method of providing financial accounting statements for a first entity(Abstract, Col. 13, Lines 10-30, Col. 14, lines 50-60, Col. 28, Lines 60-67, Col. 29, Lines 1-5), comprising:

providing transaction codes, including standardized codes(Abstract, Col. 17, Lines 9-35,Col. 22, Lines 40-50);

the first entity conducting with a plurality of other entities separate financial transactions(Abstract, Col. 12, Lines 50-65);

associating at least one of the transaction codes(Abstract, Col. 17, Lines 9-35,Col. 22, Lines 40-50) at about the time when funds are transferred or instructions are given for transfer to complete each financial transaction (Abstract, Col. 8, Lines 55-67);

transmitting a record of each transaction and the at least one transaction code via a network to at least one file(Abstract, Col. 12, Lines 20-30, Col. 15, Lines 1-5); and

sorting the transactions in the at least one file and producing an accounting statement(Abstract, Col. 12, Lines 30-45).

Official notice is taken that it is old and well known in the accounting and financial systems computer art to get the advantage of providing financial accounting statements in the form of an electronic cash letter. It would have been obvious to one of ordinary

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skill in the art at the time of applicant's invention to include financial accounting statements in the form of automatically updated electronic cash letter to get the advantage of transmitting financial transactions and updated reports reflecting the financial transactions.

Re claims 29, 52, 56 and 60: Josephson et al. disclose wherein the separate financial transactions include the transfer of funds and the instructions for transfer of funds(Abstract, Col. 24, Lines 35-50, Col. 25, Lines 25-45, Col. 27, Lines 1-50).

Re claims 30, 53, 57 and 61, Josephson et al. disclose wherein the at least one transaction code(Abstract, Col. 17, Lines 9-35,Col. 22, Lines 40-50) is selected by the first entity (Abstract, Col. 14, Lines 19-30, Col. 16, Lines 49-67).

Re claim 31: Josephson et al. wherein the at least one transaction code(Abstract, Col. 17, Lines 9-35,Col. 22, Lines 40-50) is selected by at least one of the other entities(Josephson et al., Abstract, Col. 16, Lines 49-67).

Re claims 32, 54, 58 and 62: Josephson et al. disclose wherein the standardized codes comprise financial transaction codes(Abstract, Col. 17, Lines 9-35,Col. 22, Lines 40-50).

Re claim 33: Josephson et al. wherein the transmission of the record of each transaction and at least one transaction code(Abstract, Col. 17, Lines 9-35,Col. 22, Lines 40-50) is initiated at about the time when funds are transferred or instructions are given for the transfer of funds(Abstract, Col. 8, Lines 55-67).

Re claim 35: Josephson et al. including entering into said file information regarding said first entity(Abstract, Col. 14, Lines 19-60, Col. 16, Lines 49-67, Col. 19, Lines 20-60, Col. 21, Lines 20-35, Col. 22, Lines 35-50).

Re claim 37, Josephson et al. including entering into said file coding information appropriate to said first entity (Abstract, Col. 22, Lines 40-50, Col. 24, Lines 1-35, Col. 26, Lines 1-30).

Re claims 41 and 68, Josephson et al. disclose including providing a funds transfer facility to facilitate transfer of funds to and from said first entity and said other entities(Abstract, Col. 11, Lines 30-55, Col. 12, Lines 20-65, Col. 27, Lines 1-20).

Re claims 42 and 47, Josephson et al. disclose employing said funds transfer facility to receive an instruction to transfer funds; and transferring funds from said first entity to said other entities based on said instruction(Abstract, Col. 11, Lines 30-55, Col. 12, Lines 20-65, Col. 14, Lines 20-60, Col. 15, Lines 1-5, Col. 27, Lines 1-20).

Re claim 43, Josephson et al. including employing said funds transfer facility to transmit data related to said transfer of funds(Abstract, Col. 11, Lines 30-55, Col. 12, Lines 20-65, Col. 14, Lines 20-60, Col. 15, Lines 1-5, Col. 16, Lines 50-67, Col. 17, Lines 50-65, Col. 27, Lines 1-20).

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Re claim 44, Josephson et al. including employing said funds transfer facility to adjust current records(Abstract, Col. 11, Lines 30-55, Col. 12, Lines 25-65, Col. 19, Lines 50-67, Col. 21, Lines 20-35, Col. 25, Lines 25-45, Col. 26, Lines 10-56).

7. Claims 34, 36, 39, 40, 46, 48, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Josephson et al. as applied to claim 28, 35 and 45 above, and further in view of Lyons et al. (US 4989141A).

Re claim 34, Josephson et al. disclose the method of Claim 28, wherein the transaction codes(Abstract, Col. 17, Lines 9-35, Col. 22, Lines 40-50) are provided from a menu(Lyons et al., Abstract, Col. 5, Lines 37-55, Table II).

Josephson et al. does not explicitly disclose(s) codes provided from a menu. However, in col. 5, lines 37-55, and Table II thereof, Lyons et al. disclose(s) codes provided from a menu. Thus, it would have been obvious to one with an ordinary level of skill in the art to use codes provided from a menu as taught by Lyons et al. to ensure speedy and accurate code selection.

Re claim 36: Josephson et al. does not explicitly disclose(s) wherein said information includes beginning balances for income, expenses, assets, liabilities and/or bank accounts. However, in Col. 2, Lines 35-45, Col. 4, Lines 15-30, 50-67, thereof, Lyons et al. disclose(s) beginning balances for income, expenses, assets, liabilities and/or bank accounts. Thus, it would have been obvious to one with an ordinary level of skill in the art to include these beginning balances to ensure financial accounting data is separated into the relevant financial statement.

Re claims 39, 40 and 48: Josephson et al. does not explicitly disclose(s) providing a subsidiary ledger, for each of said other entities; and transferring selected subsidiary ledgers, providing access to said subsidiary ledger, and for said first entity and/or agents of said first entity, whereby said first entity and/or agent can perform one or more activities selected from the group consisting of entering, deleting, reviewing, adjusting and processing said data inputs in said selected subsidiary ledgers.

However, in the abstract, Col. 2, Lines 15-25 and Col. 3, Lines 1-35 thereof, Lyons et al. disclose(s) providing a subsidiary ledger, for each of said other entities; and transferring selected subsidiary ledgers, providing access to said subsidiary ledger, and for said first entity and/or agents of said first entity, whereby said first entity and/or agent can perform one or more activities selected from the group consisting of entering, deleting, reviewing, adjusting and processing said data inputs in said selected subsidiary ledgers. Thus, it would have been obvious to one with an ordinary level of skill in the art to ensure smooth automatic accounting data updates as new data is added into the financial accounting system.

Re claim 46: Josephson et al. does not explicitly disclose(s) a first said file in said first computer for receiving accrual accounting data inputs; and a second said file in said first computer for receiving cash accounting data inputs. However, in Col. 4, Lines 15-67

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thereof, Lyons et al. disclose(s) a first said file in said first computer for receiving accrual accounting data inputs; and a second said file in said first computer for receiving cash accounting data inputs. Thus, it would have been obvious to one with an ordinary level of skill in the art to store and sort financial accounting data for analysis.

Re claims 49 and 50: Josephson et al. does not explicitly disclose(s) said first computer is a personal computer, and wherein said second computer is a personal computer. However, in Col. 4, Lines 1-15 thereof, Lyons et al. disclose(s) first computer is a personal computer, and wherein said second computer is a personal computer. Thus, it would have been obvious to one with an ordinary level of skill in the art to store and sort financial accounting data for analysis.

8. Claims 38, 63, 64, 65, 66 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Josephson et al. (US 5412190) as applied to claim 28 above and in view of Parker (US 4958368).

Re claim 38: Josephson et al. does not explicitly disclose(s) said first entity and/or agents of said entity a passcode to permit access to said file. However, in Abstract, Col. 4, Lines 45-67, Col. 10, Lines 1-26 thereof, Parker disclose(s) said first entity and/or agents of said entity a passcode to permit access to said file. Thus, it would have been obvious to one with an ordinary level of skill in the art to limit rights to a data file to only those authorized.

Re claims 63, 64, 65, 66 and 70: Josephson et al. disclose the conveying instructions for performing a method for producing an accounting statement for a first entity(Abstract, Col. 13, Lines 10-30, Col. 14, lines 50-60, Col. 28, Lines 60-67, Col. 29, Lines 1-5), comprising:

providing transaction codes, including standardized codes(Abstract, Col. 17, Lines 9-35, Col. 22, Lines 40-50);

the first entity conducting with a plurality of other entities separate financial transactions(Abstract, Col. 12, Lines 50-65);

associating at least one of the transaction codes(Abstract, Col. 17, Lines 9-35, Col. 22, Lines 40-50) at about the time when funds are transferred or instructions are given for transfer to complete each financial transaction(Abstract, Col. 8, Lines 55-67);

transmitting a record of each transaction and the at least one transaction code via a network to at least one file(Abstract, Col. 12, Lines 20-30, Col. 15, Lines 1-5); and

sorting the transactions in the at least one file and producing an accounting statement(Abstract, Col. 12, Lines 30-45).

And Josephson et al. disclose wherein the separate financial transactions include the transfer of funds and the instructions for transfer of funds(Abstract, Col. 24, Lines 35-50, Col. 25, Lines 25-45, Col. 27, Lines 1-50).

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And Josephson et al. disclose wherein the at least one transaction code(Abstract, Col. 17, Lines 9-35, Col. 22, Lines 40-50) is selected by the first entity(Abstract, Col. 14, Lines 19-30, Col. 16, Lines 49-67).

And Josephson et al. disclose wherein the standardized codes comprise financial transaction codes(Abstract, Col. 17, Lines 9-35, Col. 22, Lines 40-50).

And Josephson et al. disclose performing a method for providing financial accounting statements for a first entity(Abstract, Col. 13, Lines 10-30, Col. 14, lines 50-60, Col. 28, Lines 60-67, Col. 29, Lines 1-5), comprising:

providing a first computer having at least one file from which an accounting statement may be generated(Abstract, Col. 17, Lines 9-35, Col. 22, Lines 40-50);

providing a second computer for receiving data inputs, said data inputs including electronically recorded financial transactions made between said first entity and a second entity(Abstract, Col. 11, Lines 30-55, Col. 12, Lines 20-65, Col. 27, Lines 1-20);

transferring said data inputs via a communication network from said second computer to said file of said first computer(Abstract, Col. 12, Lines 20-30, Col. 15, Lines 1-5);

performing two or more activities selected from the group consisting of entering, deleting, reviewing, adjusting and processing said data inputs; and

producing said accounting statement(Abstract, Col. 12, Lines 30-45).

Josephson et al. does not explicitly disclose(s) carrier wave. However, in the Abstract thereof, Parker disclose(s) carrier wave. Thus, it would have been obvious to one with an ordinary level of skill in the art to transmit data via wireless.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Debra F. Charles

Examiner

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dfc

May 19, 2003


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600